

# UNDERSTANDING TRADEMARKS COURSE

JULY 10-14, 2023



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Intellectual Property Institute of Canada  
Institut de la propriété intellectuelle du Canada



**McGill**

School of  
Continuing Studies



# IPIC-McGill Understanding Trademarks Course 2023

## **Join Professionals from Across the Country to Learn from Leading Practitioners in the Field of IP**

Since 1994, the Intellectual Property Institute of Canada and McGill University have gathered some of the top practitioners in the field of intellectual property to conduct a series of intensive, practical summer courses in intellectual property. More than 2,500 professionals from the business, legal, and public sectors have gained valuable insight and hands-on experience by participating in our unique summer program. Our courses are also an excellent opportunity to network with individuals from diverse backgrounds who have an interest in Canadian intellectual property.

Each year, the program offers a comprehensive suite of pragmatic courses to help practitioners in the legal, business, and government sectors keep up to date on the latest in intellectual property. Taught by seasoned IP professionals, the program is made up of three specialized courses in the areas of patents, trademarks, and copyright. Participants can sign up for individual modules, full courses, or enrol in the entire program to gain knowledge of a specific aspect of IP, acquire the insights needed to protect a portfolio of intellectual property, or advance their careers in the area of IP law.

# Understanding Trademarks

An Introductory Course: Monday, July 10, 2023 to Friday, July 14, 2023

Module 1 (2 days) Basics of Canadian Trademark Prosecution (July 10-11)

Module 2 (3 days) Fundamentals of Trademark Management and Contentious Proceedings (July 12-14)



*This course is essential for all in house lawyers in Canada that practice intellectual property.*

**Nicholas Cirino**

Counsel, Commercial and Regulatory  
Air Canada



*Well organized, lots of great information! The presenters are top in their fields. Highly recommend this program!*

**Josie Uberg**

Coordinator, Legal Services  
Canadian Blood Services



*The Understanding Trademarks summer program was a professionally delivered course that has served me well in private industry. The class leaders were both interesting and engaging and their presentation contained the right mix of technical material, relevant case studies and personal commentary.*

**Richard Cook**

CA, President Kamik Footwear



*An introductory pre requisite for anyone considering practicing in trademarks. Moreover, why would you learn just from books when you can learn directly from those who wrote many of them and argued the cases contained therein!*

**Jonathon L. Wescott**

B.A. B.Mgt. LL.B.  
Emery Jamieson LLP



*This course is extremely relevant to current trademark practices. Highly recommend it to anyone who works in trademarks or is interested in working in the IP field.*

**Suzeth Westres**

Trademark assistant  
Morency S.E.N.C.R.L.

## STAY ON TOP OF THE LATEST ISSUES

The trademark landscape in Canada has drastically changed over the last few years, and this course is designed to help educate you on how to protect a brand's most valuable asset. It is more important than ever to learn the nuances associated with the many different ways to distinguish a brand's goods and services from others, learn what you can and cannot register, and respond to Examiners' reports, opposition proceedings and enforcement/litigation issues post-registration. Learn valuable insights from Canada's leading practitioners in workshops and interactive lectures.

## INTERACT WITH EXPERIENCED PROFESSIONALS

The in-person format with integrated social and networking events, provides a great opportunity for you to interact with the speakers, workshop leaders, participants and professionals from diverse backgrounds. Take advantage of these events to stay on top of practice and trends and create meaningful working connections and relationships than can last your entire career. Lectures and workshops cover both theoretical & practical aspects of trademark prosecution, portfolio management, contentious proceedings, together with information and tools on international filing systems, including the Madrid Protocol. With live lectures and workshops, the course will cover all aspects of the Canadian trademark regime and provide "best practices" advice and tips.

## MONDAY, JULY 10, 2023

9:00 a.m. – 4:00 p.m. EDT

### MODULE 1

#### BASICS OF CANADIAN TRADEMARK PROSECUTION

##### Opening Remarks 8:45 a.m. to 9:00 a.m.

Course Director:

**David S. Lipkus** Lipkus Law LLP

Assistant Course Director:

**Andrea Kroetch** Stikeman Elliott LLP

##### Selecting Great Trademarks 9:00 a.m. to 10:30 a.m.

**Jean-Philippe Mikus** Fasken Martineau DuMoulin LLP

- ▶ Legal considerations
- ▶ Distinctiveness: inherent/acquired
- ▶ Confusion: 3rd party marks on the register vs. in the marketplace
- ▶ Marketing considerations & their impact: visual impact, impact when sounded, and other languages/cultures

##### Trademark Applications: Filing Requirements and Special Types of Applications

10:30 a.m. to 11:30 a.m.

1:00 p.m. to 3:00 p.m.

**Christian Bolduc** Smart & Biggar LLP

- ▶ Introduction to the Trademarks Office
- ▶ Preparing trademark applications
- ▶ Procedure & forms
- ▶ Information required
- ▶ Priority dates
- ▶ Registrability restrictions
- ▶ Linguistic and other considerations

## THIS YEAR'S COURSE WILL COVER:

- ▶ Selecting great trademarks
- ▶ Preparing and filing Canadian and Madrid applications
- ▶ Conducting and reporting clearance searches
- ▶ Reporting and responding to Examiners' reports
- ▶ Maintaining trademark rights and best practices
- ▶ In-house perspective for managing portfolios
- ▶ Opposition proceedings and settlement strategies
- ▶ Anti-counterfeiting investigation and enforcement
- ▶ Trademark litigation in Canada and in the US

## WHO SHOULD ATTEND

**Lawyers, trademark agents, in-house counsels, brand portfolio managers, marketing & brand creation specialists and professionals** seeking a greater understanding of trademark law and practice, **young professionals** considering entering the field of trademarks, **people new to the profession**, and **any professionals seeking to refresh or broaden** their knowledge and skill set can all benefit from the course. Valuable course materials are provided, plus daily workshops with experienced practitioners.

- ▶ Special applications
- ▶ Certification marks
- ▶ Official marks
- ▶ Mode of packaging/3D marks

##### Workshop: Trademark Filing Strategies

3:00 p.m. to 4:00 p.m.

##### Social/networking

4:00 p.m. to 5:00 p.m.

## TUESDAY, JULY 11, 2023

9:00 a.m. – 4:00 p.m. EDT

##### International (Madrid) Trademark Applications:

**Filing Requirements and Maintenance 9:00 a.m. to 10:00 a.m.**

**Jennifer McKenzie** Cassels Brock & Blackwell LLP

- ▶ Filing strategies; an overview of Madrid (International) applications
- ▶ Madrid Protocol systems: advantages and disadvantages
- ▶ Registration & post-registration issues; enforcement

##### The Basics of Trademarks Use in Canada: The Who, What, Where, When, Why, How and Future 10:00 a.m. to 11:30 a.m.

**Paula Clancy** Gowling WLG (Canada) LLP

- ▶ Concept of use
- ▶ Types of use
- ▶ Time of use
- ▶ Use by whom
- ▶ Location of use
- ▶ Nature of use



## Clearance Searches, Examiners' Reports & Responses, Post-Advertisement Matters 1:00 p.m. to 3:00 p.m.

Meghan Dillon Bereskin & Parr LLP

- ▶ Conducting clearance searches
- ▶ Technical and substantive objections
- ▶ Responding to Examiners' reports
- ▶ Amendments to applications
- ▶ Voluntary withdrawals and abandonment
- ▶ Approval and advertisement
- ▶ Renewals
- ▶ Other legislation affecting trademarks

## Workshop: Reporting Examiners' Reports

3:00 p.m. to 4:00 p.m.

## WEDNESDAY, JULY 12, 2022

9:00 a.m. – 4:00 p.m. EDT

### MODULE 2

## FUNDAMENTALS OF TRADEMARK MANAGEMENT AND CONTENTIOUS PROCEEDINGS

### Opposition Proceedings: Overview, Context & Strategy

9:00 a.m. to 11:30 a.m. - 1:00 p.m. to 3:00 p.m.

Philip Lapin Smart & Biggar LLP

- ▶ Context
- ▶ Length of oppositions, costs & strategy considerations
- ▶ Procedures & Steps
- ▶ Why oppose?
- ▶ Extensions of the time including retroactive extensions
- ▶ Evidence
- ▶ Written arguments and hearings
- ▶ Options for settlement

### Workshop: Tips and Strategies in Opposition Proceedings

3:00 p.m. to 4:00 p.m.

## THURSDAY, JULY 13, 2023

9:00 a.m. – 4:00 p.m. EDT

### Overview of Trademark Litigation in Canada – Infringement, Passing Off & Depreciation of Goodwill

9:00 a.m. to 11:00 a.m.

Amrita V. Singh Marks & Clerk Canada

- ▶ Enforcement strategies for registered and common law trademark
- ▶ Causes of actions: infringement, passing-off, depreciation of goodwill
- ▶ Marshalling relevant evidence for proof of infringement
- ▶ Defence strategies to challenge distinctiveness and validity
- ▶ Counterfeiting issues in Canada
- ▶ Remedies (Anton Piller Orders, injunctions, recovery of damages or profits, destructions, customs remedies)
- ▶ Domain name disputes

### LUNCH & LEARN

11:30 a.m. to 1:00 p.m.

### 2023 TRADEMARK WOES: Licensing + Collabs and its Impacts on Brand Image

Beth Henries Henries PLLC

### Life After Registration 1:00 p.m. to 3:00 p.m.

Henry Lue Wilson Lue LLP

- ▶ Registration and renewal
- ▶ Maintenance of registration and proper use
- ▶ Possible expungement by Registrar or third parties
- ▶ Post-registration amendments, assignments and recordal of documents

### Workshop: Trademark Clearance Searches

and Risk Assessments 3:00 p.m. to 4:00 p.m.

## FRIDAY, JULY 14, 2023

9:00 A.M. – 2:00 P.M. EDT

### Managing Your Assets: An In-House Perspective

9:00 a.m. to 10:00 a.m.

Geneviève Prévost Molson Coors Brewing Company

- ▶ Strategies for searches, clearance and reporting
- ▶ Managing your IP portfolio to maximize asset value – aligning IP strategy with your business strategy
- ▶ Managing relationships: executives, marketing professionals, agencies and outside counsel
- ▶ Corporate strategies: social media, marks in ads, domains and licensing
- ▶ Monitoring and protecting your IP assets

### Trademark Litigation in the U.S. – What Practitioners

Need to Know for Canadian Clients 10:00 a.m. to 11:15 a.m.

Douglas Rettew Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

- ▶ Strategies and precautions
- ▶ Forum shopping
- ▶ Jury trial
- ▶ Preliminary & summary proceedings

### Counterfeits in Canada: How to Keep Fakes Out

of Physical and Online Marketplaces 12:00 p.m. to 2:00 p.m.

David Lipkus Lipkus Law LLP

- ▶ Counterfeit goods/rights at issues
- ▶ Identifying the target
- ▶ Investigation
- ▶ Obtaining evidence
- ▶ Online Open sources searches
- ▶ Civil/criminal/border enforcement
- ▶ Social media
- ▶ Online marketplaces
- ▶ Website enforcement
- ▶ Collaboration with third parties

### Workshop Leaders:

Brigitte Chan Bereskin & Parr LLP

Suzanne Antal Lavery de Billy LLP

Christian Bolduc Smart & Biggar LLP

Paula Clancy Gowling WLG (Canada) LLP

Catherine Daigle Norton Rose Fulbright Canada LLP

Meghan Dillon Bereskin & Parr LLP

Andrea Kroetch Stikeman Elliott LLP

François Larose Bereskin & Parr LLP

Philip Lapin Smart & Biggar LLP

Julie Larouche St. Lawrence Law Firm LLP

Chantal St. Denis O'Brien TM Services Inc.

Gabriel St-Laurent Robic LLP

Richard Whissell Perley-Robertson, Hill & McDougall LLP

## FEES

### Understanding Trademarks An Introductory Course

#### July 10 - 14, 2023

IPIC member fee.....	\$2295
Regular fee.....	\$2495
Full-time student fee .....	\$1247.50

#### Module 1

##### July 10 - 11, 2023

IPIC member fee.....	\$1140
Regular fee.....	\$1340
Full-time student fee .....	\$670

#### Module 2

##### July 12 - 14, 2023

IPIC member fee.....	\$1560
Regular fee .....	\$1760
Full-time student fee .....	\$880

#### Lunch & Learn

Included with the purchase of the full course or Module 2. Can be purchased as a stand alone for the public.

IPIC member / McGill Alumni.....	\$75
Regular fee .....	\$95
Full-time student fee .....	\$50



*I was very pleased with the program. The incredible speakers offered a comprehensive overview of the law and process of trademark registration and practice in Canada as well as comparisons with other countries. Overall, the course was invaluable and presented me with information and materials which were essential in preparation for the Trademarks Agent Exam and practice in the area.*

**Michael A. Poznanski**

Davidson Lawyers LLP

# INTELLECTUAL PROPERTY INSTITUTE OF CANADA



IPIC is the only intellectual property association in Canada to which nearly all patent agents, trademark agents and lawyers specializing in intellectual property belong.

IPIC members receive a preferential rate on registration fees for the Summer Courses in Intellectual Property.

IPIC offers additional courses in patents, trademarks and copyright. Inquire at [education@ipic.ca](mailto:education@ipic.ca)

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## **Professional & Corporate Education (PCE)**

Please visit [www.mcgill.ca/intellectualproperty](http://www.mcgill.ca/intellectualproperty) for details on course accreditation by professional bodies and law societies.



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Program is subject to change.